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## **REMARKS**

This paper is filed in response to the Office Action dated May 21, 2003. As this paper is filed on August 21, 2003, the paper is timely filed.

### **I. Status of Amendments**

Claims 1-35 were pending prior to this amendment. By this amendment, applicant cancels claims 1-35 and adds claims 36-59. Thus, claims 36-59 are now pending. Because applicant previously paid fees for 3 independent and 35 total claims, applicant's amendments do not require a further fee to be paid.

The paragraphs following the heading "Brief Summary of the Invention" have been replaced with new paragraphs that are consistent with the new claims. Applicant submits that this is in keeping with 37 C.F.R. §1.73, which states that the "summary should, when set forth, be commensurate with the invention as claimed . . . ." It is respectfully submitted that the new paragraphs do not constitute new matter.

### **II. Response to Office Action**

#### **A General Comments**

Although the application describes various embodiments and makes various statements regarding the "invention," it is well settled that the legal scope of the invention is defined by the words of the claims and that it is improper to read features of the embodiments described in the specification into the claims. It should also be recognized that the term "invention" may be used to mean various different things.<sup>1</sup> For example, the term

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<sup>1</sup> This is explained in the Glossary of Volume 1 of Chisum on Patents, where the term "invention" is defined as follows:

“invention” may be used to refer to the technical subject matter that has been invented; the term “invention” may be used to refer to subject matter which is nonobvious; and the term “invention” may be used to refer to subject matter defined by the claims of a patent. Thus, the mere fact that the present application uses the term “invention” in various statements does not mean that the scope of the claims is limited by such statements.

It should also be understood that, unless a term is expressly defined in the application using the sentence “As used herein, the term ‘\_\_\_\_\_’ is hereby defined to mean...” or a similar sentence, there is no intent to limit the meaning of that term, either expressly or by implication, beyond its plain or ordinary meaning, and such term should not be interpreted to be limited in scope based on any statement made in any section of the present application (other than the language of the claims). Finally, unless a claim element is defined by recital of the word “means” and a function without the recital of any structure, it is not intended that the scope of any claim element be interpreted based on the application of 35 U.S.C. § 112, sixth paragraph.

It is respectfully submitted that the foregoing comments regarding claim construction are consistent with 35 U.S.C. § 112 and the Office practice of utilizing the “broadest reasonable interpretation” of claims.

It is also respectfully submitted that the claims are supported by the application, that the claims satisfy the written description requirement and the other requirements of 35 U.S.C. § 112, and that no new matter is being added. In this regard, it is well settled that the specification need not reproduce the exact language of the claims to satisfy the written description requirement of § 112, first paragraph. In re Wright, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) (“[T]he claimed subject matter need not be described in haec verba in the specification in order for that specification to satisfy the description requirement.”). The

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**INVENTION** – In patent law, the word ‘invention’ has several different meanings. It may refer to (1) the act of invention through original conception and reduction to practice; (2) subject matter described and/or claimed in a patent, patent application or prior art reference (e.g., a product or process); or (3) the patentability requirement of invention, first developed by the courts and now subsumed in the statutory requirement of nonobviousness. Thus, an applicant may have invented (1) an invention (2) which is unpatentable for lack of invention (3) because it is an obvious modification of an invention (2) used by others in this country before the invention (1) thereof by the applicant.

written description requirement of §112 can even be satisfied based solely on the drawings of a patent application. Vas-Cath Inc. v. Mahurkar, 19 U.S.P.Q.2d 1111, 1118 (Fed. Cir. 1991) (“These cases support our holding that, under proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by §112”).

**B. The May 21 Office Action**

In the May 21 Office Action, claims 1-35 were rejected under 35 U.S.C. 102(e) as allegedly anticipated by Tracy et al. (U.S. Publ. No. 2002/0187825). As applicant has canceled claims 1-35, the rejection based on Tracy et al. is moot. Applicant does have the following comments in regard to Tracy et al.

At the outset, while the applicant has elected not to file a Declaration pursuant to 37 C.F.R. 1.131 at this time in an attempt to swear-behind Tracy et al., applicant submits that it does not, in so doing, admit that Tracy et al. is applicable as a reference under 35 U.S.C. 102(e). The applicant specifically reserves the right to submit such a Declaration or make such a showing in the future in an attempt to swear-behind Tracy et al.

Claim 36 is independent. Claim 36 recites a gaming method including determining that a first player has made a wager, determining that a first player has selected one of the game elements from the set of game elements, the one of the game elements known to the first player at the time the one of the game elements is selected, determining that a second player has made a wager, and determining that a second player has selected one of the game elements from the set of game elements, the one of the game elements known to the second player at the time the one of the game elements is selected. The gaming method also includes selecting a winning game element from the set of game elements, determining a game outcome according to the closeness of the one of the game elements selected by the first player and the one of the game elements selected by the second player to the winning game element, and determining a payout according the game outcome.

Tracy et al. does not disclose, teach or suggest all of the limitations of claim 36. For instance, Tracy et al. does not disclose, teach or suggest determining that a first player has selected one of the game elements from the set of game elements, the one of the game elements known to the first player at the time the one of the game elements is selected or determining that a second player has selected one of the game elements from the set of game

elements, the one of the game elements known to the second player at the time the one of the game elements is selected.

To the contrary, Tracy et al. repeatedly mentions that the player selects a number which is unknown to him or her. For example, at Para [0030], Tracy et al. states: "The issued running count number is unknown to the player until a ticket is issued, and, optionally, the issued number may be displayed at the game terminal." Similarly, at Para. [0033], Tracy et al. states: "The requested and issued unknown number (i.e., the running count number for the wager), and the time the request was made for that number, may be shown to the player on a display screen of the game terminal." In fact, Tracy et al. states at Para. [0052]: "Using a 'queue' of players' requests for numbers in time order the requests are placed helps to randomize the progress of the running count by speeding up and slowing down the assignment of numbers responsive to various player requests for numbers, making it impossible to use a mathematical algorithm to predict the timing of issuance of the winning number and thereby defeat the somewhat random (subject to some limited effect of requesting timing as skewed by requests of other players) outcome of the game."

Point of fact, the game of Tracy et al. relies in large part on the fact that the players do not know the numbers selected, for the winning condition requires the comparison of the "unknown" numbers to known numbers, e.g., every 100, 1000, 10,000 etc. For example, Tracey et al. states at Para. [0031]: "The received number [received by the player] is compared by the central controller to the winning criterion (e.g., a specific number, or a number than meets certain specific requirements, such as each hundredth number) established by, or for, the game and made available to the players. If the received number matches the established winning game criteria, the player is awarded with a payoff." If the players were permitted to select known numbers, the game would collapse.

Given that claims 37-47 depend from claim 36 and that claim 36 is distinguishable from Tracy et al., so too are claims 37-47. Moreover, it is applicant's position that the arguments distinguishing claim 36 from Tracy et al. are applicable with equal force to claim 48, and thus claim 48 distinguishes Tracy et al. It further follows that as claim 48 distinguishes Tracy et al. and claims 49-59 depend from claim 48, these claims distinguish Tracy et al. as well.

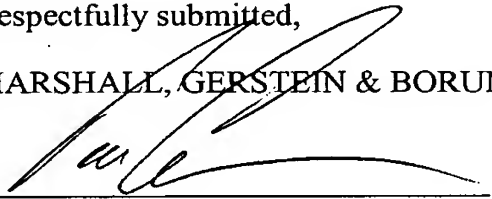
In view of the foregoing, it is respectfully submitted that the above application is in condition for allowance, and reconsideration is respectfully requested. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN

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By:



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